

### **REMARKS / ARGUMENTS**

Claims 22-40 and 42-69 are pending in the instant application. Claims 22, 47, and 60 are independent. Claims 23-40 and 43-46, claims 48-59, and claims 61-69 depend from independent claims 22, 47, and 60, respectively.

Claims 22-40, 42, 43, 45-66, 68, and 69 were rejected. Claims 44 and 67 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 22, 23, 27, 28, 47, 48, 52, 53, 54, 60, 61, and 65-67 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. Support for the amendments to claims 22, 47, and 60 may be found, for example, at Fig. 55a, Fig. 56a, and at pages 254-271 of the Specification. Applicants respectfully submit that no new matter is added by these amendments.

New claims 70-81 have been added. Claims 70, 74, and 78 merely recite language taken from independent claims 22, 47, and 60. Support for new claims 72-73, 75-77, and 79-81 may be found, for example, at Fig. 55a, Fig. 56a, and at pages 254-271 of the Specification. Applicants respectfully submit that new claims 70-81 do not add new matter.

The Applicants respectfully submit that the claims define patentable subject matter.

Claims 22, 23, 27-29, 31, 32, 34, 36, 45-49, 52-55, 57-61, 64-66, 68, and 69 stand rejected under 35 U.S.C. § 102(e) as being anticipated by USP 7,778,642 ("Ziv"). Claims 24-26, 50, 51, 62, and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziv in view of USP 5,729,544 ("Lev"). Claims 30 and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziv in view of USP 5,526,353 ("Henley"). Claims 33, 37-40, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziv in view of USP 5,604,737 ("Iwami"). Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziv in view of USP 5,764,741 ("Barak"). Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ziv in view of USP 5,774,854 ("Sharman").

Though the Applicants generally disagree with such rejections, to expedite allowance of various pending claims, the following discussion will focus in part on particular independent and dependent claims and/or portions thereof. Note that such focus is in no way to be construed as the Applicants agreeing with any rejections not specifically discussed below. The Applicants respectfully traverse the above rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

## REJECTION UNDER 35 U.S.C. § 102

### I. **Ziv Does Not Anticipate Claims 22, 23, 27-29, 31, 32, 34, 36, 45-49, 52-55, 57-61, 64-66, 68, and 69**

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP § 2131. To anticipate, a reference must “**clearly and unequivocally disclose the claimed [invention]** or direct those skilled in the art to the [invention] **without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference.**” *Akzo v. U.S. Int’l. Trade Comm’n.*, 808 F.2d 1471, 1480 (Fed. Cir. 1986).<sup>1</sup> In other words, to be anticipatory, the prior art reference “must not only disclose all elements of the claim within the four corners of the document, **but must also disclose those elements 'arranged as in the claim.'**” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008), quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

With these principles in mind, the Applicants now turn to the claim rejections in particular. Namely, the Applicants turn to the rejection of claims 22, 23, 27-29, 31, 32, 34, 36, 45-49, 52-55, 57-61, 64-66, 68, and 69 under 35 U.S.C. § 102(e) as being anticipated by Ziv.

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<sup>1</sup> Emphasis added except where noted otherwise.

Without conceding that Ziv qualifies as prior art under 35 U.S.C. § 102(e), the Applicants respectfully traverse this rejection as follows.

**A. Rejection of Independent Claim 22 under 35 U.S.C. § 102(e)**

With regard to the rejection of independent claim 22 under Ziv, the Applicants submit that Ziv does not disclose or suggest at least the limitation of “interface circuitry for receiving from an information transmission device, information requesting setup of a call path between a first communication network and a second communication network, and for sending to the information transmission device, parameters for configuring the information transmission device to cause setup of the requested call path,” as now recited by the Applicants in independent claim 22.

The Office Action states the following:

**Regarding claim 22**, Ziv et al. disclose a communication system controller (fig. 2; controller 250 comprises CCP) comprising: interface circuitry for communicating, with an information transmission device, information requesting setup of a call (**col. 8 lines 26-27; CCP signals the system 101 during call set up requested by a subscriber to initiate a telephone call**) and parameters for configuring the information transmission device...

(emphasis in original).

See Office Action at page 2. The Applicants submit that the Office Action seemingly identifies the “controller 250” comprising the “CCP” of Ziv as teaching Applicants’ claimed “controller” and “interface circuitry,” respectively, but has not shown where Ziv teaches that the cited “CCP” receives “from an information transmission device, information requesting setup of a call path between a first communication network and a second communication network,” as now recited by claim 22. Instead,

the Office asserts that Ziv teaches that the “CCP signals the system 101 during call setup requested by a subscriber to initiate a telephone call.” Thus, Applicants respectfully submit that the Office has not shown that Ziv teaches at least this aspect of claim 22.

In addition, claim 22 now recites, in part, “at least one processor operably coupled to the interface circuitry and to memory arranged to store digitized voice information.”

The Office action states the following:

At least one processor operably coupled to the interface circuitry  
**(col. 7 lines 32-34; CCP is comprised of circuitry and a microprocessor for executing instructions);**  
(emphasis in original).

Thus, the Office seemingly identifies the “at least one processor” as being taught by a “microprocessor” of the cited “CCP” of Ziv, which the Office identified as teaching Applicants’ claimed “interface circuitry.” Applicants respectfully submit, however, that the Office has not shown where Ziv teaches that the cited “microprocessor” of Ziv is “operably coupled ... to memory arranged to stored digitized voice information,” as recited by claim 22. Thus, Applicants respectfully submit that the Office has not shown that Ziv teaches at least this aspect of claim 22.

Accordingly, as amended, independent claim 22 is not anticipated by Ziv and is allowable. Independent claims 47 and 60 recite features similar in many respects to those of independent claim 22. Therefore, the Applicants submit that independent

claims 47 and 60 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 22.

**B. Rejection of Dependent Claims 23, 27-29, 31, 32, 34, 36, 45, 46, 48, 49, 52-55, 57-59, 61, 64-66, 68, and 69**

Based on at least the foregoing, the Applicants believe that the rejection of independent claims 22, 47, and 60 under 35 U.S.C. § 102(e) as being anticipated by Ziv has been overcome and requests that the rejection be withdrawn. Additionally, claims 23, 27-29, 31, 32, 34, 36, 45, 46, 48, 49, 52-55, 57-59, 61, 64-66, 68, and 69 depend from independent claims 22, 47, and 60 and are, consequently, also respectfully submitted to be allowable.

With respect to dependent claim 34, the Office states, “[r]egarding claim 34, Ziv et al. further disclose wherein the operational software is capable of determining a routing for the requested call (col. 4 lines 53-57).” See Office action at page 4. The cited portion of Ziv, however, merely states, “[i]f wireless telephone system 101(A) determines that the telephone call from wireless subscriber unit 100(A) is directed to wireless subscriber unit 100(B), the route through which the data associated with the telephone call is different than that of the telephone call between wireless subscriber unit 100(A) and wire based subscriber unit 106(A).” Applicants respectfully submit that the cited portion of Ziv makes no mention that the “microprocessor” of “CCP 206,” which the Office identified as teaching Applicants’ “at least one processor” that executes the “operational software,” is “capable of determining a routing for the requested call,” as required by claim 34. Therefore, Applicants respectfully submit that the cited portion of

Ziv does not teach each and every element of Applicants' claim 34, and that claim 34 is allowable over Ziv.

With respect to dependent claim 45, the Office states, "[r]egarding claim 45, Ziv et al. further teach wherein the interface circuitry is capable of communicating digitized voice information with the information transmission device (see col. 7 lines 37-46; CCP communicates vocoded data [sic] with service options element 210)." See Office action at page 4. The cited portion of Ziv, however, simply states the following:

If CCP 206 determines that the call from wireless subscriber unit 100(A) is not directed to another wireless subscriber unit 100(A) is not directed to another wireless subscriber unit, but is directed to a wire based subscriber unit 106, such as wire based subscriber unit 106(A) of FIG. 1, it allocates and configures a selector resource within selector element bank 204 to forward vocoded data from wireless subscriber unit 100(A) to service options element 210. Service options element 210 is configured by CCP 206 to devocode the vocoded data and to place the devocoded data into PCM format. The PCM formatted data is passed into PSTN interface 212 which introduces the PCM formatted data into local PSTN 102(A) (FIG. 1).

The Office has identified the claimed "interface circuitry" as taught by "CCP 206" of Ziv. The cited portion of Ziv shown above does not teach that "CCP 206" is "capable of communicating digitized voice information." Instead, Ziv teaches that "CCP 206" determines that a call from one "wireless subscriber unit" is not directed to another "wireless subscriber unit," and then allocates and configures a "selector resource" within ref. 204 to forward "vocoded data." That is, Ziv teaches that it is the "selector resource" that communicates (forwards) "vocoded data" from one "wireless subscriber unit" to "service options element 210." While "CCP 206" configures "service options element

210,” that is quite different from teaching that the “CCP 206” is “capable of communicating digitized voice information with the information transmission device,” as required by claim 45. Therefore, Applicants respectfully submit that the cited portion of Ziv does not teach each and every element of Applicants’ claim 45, and that claim 45 is allowable over Ziv.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 23, 27-29, 31, 32, 34, 36, 45, 46, 48, 49, 52-55, 57-59, 61, 64-66, 68, and 69.



## REJECTION UNDER 35 U.S.C. § 103

The determination of obviousness is a legal conclusion based on underlying findings of fact.<sup>1</sup> The factual inquiries, set forth in *Graham v. John Deere Co.*<sup>2</sup>, include: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims, (3) the level of ordinary skill in the relevant art, and (4) any objective indicia of non-obviousness. Initially, the burden is on the Examiner to establish a *prima facie* case of obviousness<sup>3</sup>. “If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”<sup>4</sup> More specifically, MPEP at § 2142 states:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

“The determination of obviousness is made with respect to the subject matter as a whole, not to separate pieces of the claim.”<sup>5</sup> Accordingly, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”<sup>6</sup> If, considering the claim as a whole, the Examiner deems the claim to be obvious in view of the prior art, the Examiner must provide a “clear articulation of the reason(s) why the claimed invention would have been obvious.”<sup>7</sup> The Examiner’s determination of

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<sup>1</sup> *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1085 (Fed. Cir. 2008).

<sup>2</sup> 383 U.S. 1, 86 S.Ct. 684 (1966)

<sup>3</sup> MPEP § 2142

<sup>4</sup> *Id.*

<sup>5</sup> *Apotex*, 550 F.3d 1075 at 1086. (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed.Cir.1984)).

<sup>6</sup> MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

<sup>7</sup> MPEP § 2142.

obviousness “cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>8</sup>

In reviewing an Examiner’s determination of obviousness, “the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”<sup>9</sup>

With these principles in mind, the Applicants now turn to the claim rejections in particular.

## **II. The Proposed Combinations of Ziv and Lev, Henley, Iwami, and/or Barak Does Not Render Claims 24-26, 30, 33, 35, 37-40, 42, 43, 50, 51, 56, 62-63 Unpatentable**

Applicants respectfully submit that independent claims 22, 47, and 60 have been shown above to be allowable over Ziv. Applicants believe that claims 22, 47, and 60 are allowable over the proposed combinations of Ziv in view of Lev, Henley, Iwami, and/or Barak in that the Office has not shown that any of the cited art overcomes the shortcomings of Ziv, set forth above with respect to claims 22, 47, and 60.

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<sup>8</sup> *KSR*, 550 U.S. 398 at 418 (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)).

<sup>9</sup> *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). *See also In re Vaidyanathan*, Appeal 2009-1404 at 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) (“If the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that [the Appellant’s] claims are obvious.”).

Accordingly, the proposed combinations of Ziv with any of Lev, Henley, Iwami, and/or Barak do not render independent claims 22, 47, and 60 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicants submit that claim 22, 47, and 60 are allowable over the cited art, and that claims 24-26, 30, 33, 35, 37-40, 42, 43, 50, 51, 56, 62-63, which depend from claims 22, 47, and 60, are also allowable, for at least the same reasons.

The Applicants also reserve the right to argue additional reasons beyond those set forth above to support the allowability of claims 24-26, 30, 33, 35, 37-40, 42, 43, 50, 51, 56, 62-63.

In general, the Office Action makes various statements regarding claims 22-40 and 42-69 and the cited references, which statements are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

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### **CONCLUSION**

Based on at least the foregoing, the Applicants believe that all claims 22-40 and 42-81 are in condition for allowance. If the Examiner disagrees, the Applicants respectfully request a telephone interview, and request that the Examiner telephone the undersigned Agent at (312) 775-8171.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: October 4, 2011

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